

## REMARKS/ARGUMENTS

### **1.) Claim Amendments**

In order to expedite prosecution, and limit the claims for a potential appeal, the Applicants have cancelled, without prejudice, claims 25-28. Accordingly, claims 1-18 and 20-24 remain pending in the application.

### **2.) Claim Rejections – 35 U.S.C. §103(a)**

The Examiner has rejected claims 1-5, 7-18, and 20-28 as being unpatentable over Tseng, *et al.* (U.S. Patent No. 6,172,974) in view of Tso, *et al.* (U.S. Patent No. 6,421,733); and claim 6 as being unpatentable over Tseng in view of Tso and Shaffer, *et al.* (U.S. Patent No. 6,324,409). Claims 25-28 have been cancelled and, therefore, the rejections thereof are moot. The Applicants traverse the rejection of claims 1-18 and 20-24.

In the prior office action, the Examiner rejected the claims as anticipated by Tseng. In the present “final” office action, the Examiner asserts that “Applicant’s arguments filed July 17, 2009 have been fully considered but they are not persuasive.” The Examiner’s rejections in the present office action, however, are based on the teachings of Tseng combined with the teachings of Tso. Tso, however, fails to teach that which the Examiner asserts.

In the prior office action, the Examiner asserted that:

Claim 1 “is anticipated by Tseng et al. where a method is presented to perform the bypassing of a pair of transcoders on the local side the other at the distant side of the communication network (column 5, line 62-67, column 6, line 1-5).

That was the complete extent of the Examiner’s stated basis for substantively rejecting claim 1; the Examiner did not independently identify where each element/limitation of claim 1 is taught in Tseng. In the present office action, the Examiner acknowledges that “Tseng does not address the version of the transcoder (or the bypassing protocol).”<sup>1</sup> To

<sup>1</sup> In the present office action, the Examiner has again not pointed to specific teachings in Tseng, or the other references, of all claim limitations. The Applicants cannot present arguments in a vacuum and, thus, only directly address the Examiner’s stated arguments in the present office action. The Applicants, however, reserve the right to traverse any further arguments put forward by the Examiner when directed to specific teachings of any reference.

overcome the now acknowledged deficiency of Tseng, the Examiner looks to the teachings of Tso. Tso, however, fails to teach that which the Examiner asserts.

After acknowledging that Tseng "does not address the version of the transcoder (or the bypassing protocol)," the Examiner states that Tso:

"discloses that different transcoded version of the hypertext object, which may be retrieved or appended to by one of transcode service providers (col. 5, lines 24-25). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to add in the invention of Tseng the limitations as explicitly describe by Tso et al., in order to provide a version of the transcoder."

It appears that the Examiner is merely picking and choosing technical terms found in Applicants' claims from the prior art, without any regard as to the functions of the claim elements or the purpose of the claimed invention. Furthermore, the Examiner does not provide any rationale for why one of ordinary skill in the art would consider the teachings of Tseng and Tso, in combination, if attempting to solve the technical problem addressed by Applicants' invention, which is to bypass a pair of transcoding operations performed in series by a first transcoder arranged together with a first communication terminal on a local side of a communication network and by a second transcoder arranged together with a second communication terminal on a distant side of the communication network. The Examiner has merely pointed to a single sentence in Tso that has nothing to do with the stated element of Applicants' claim, much less the function of the element or the purpose of the claim. In isolation, the claim element relates to including a version of a bypassing protocol supported by transcoder in a request to bypass transcoding operations. In contrast, the portion of Tso referenced by the Examiner relates to a "transcoded version of [a] hypertext object." In other words, Tso is discussing a version of a hypertext object that has been transcoded; it has nothing to do with a transcoder or differentiating between a bypassing protocol. Therefore, the Examiner has not established a *prima facie* case of obviousness of claim 1.

Whereas independent claim 20 recites limitations analogous to those of claim 1, it is also patentable over the teachings of Tseng and Tso. Furthermore, whereas claims 2-18 and 21-24 are dependent from claims 1 and 20, respectively, and include the

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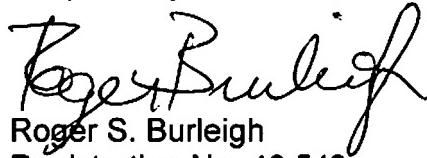
limitations thereof, they are also not obvious in view of those references, or further in view of Shaffer.

### CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-18 and 20-24.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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